REMARKS

Reconsideration of the application in light of the following remarks is respectfully requested.

Claims 15, 16, 21, 22 and 27-89 are pending.

Rejection Under 35 U.S.C. § 103

Claims 15, 16, 21, 22, 27-89 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 7,076,443 to Emens et al. ("Emens") in view of U.S. Patent No. 5,835,087 to Herz et al. ("Herz"). Applicants respectfully traverse the rejection.

In rejecting independent claim 15, the Examiner asserts that each of its limitations is disclosed in Emens, except for the content being accessed in response to submission of a URL by the user. The Examiner asserts that this feature is disclosed by Herz.

Applicants submit that the claimed invention is patentable over the combination of Emens and Herz for at least the following key points:

- Each independent claim recites that the requested content and associated advertising be displayed together. The effect of submitting the URL in the claimed invention is that an advertisement and the content at the URL are pulled to a user's work station for display together.

- The Examiner contends that it would be obvious to use a URL to obtain the content in view of Herz. However, Emens clearly teaches away from Herz. There is no motivation to combine.

- Even if Emens were combined with Herz, the result would not be the claimed invention. Emens requires intervening entities between the user and the Internet sites, and Herz requires user profile information to determine relevant advertisements. Neither of these features are in the present claims. The claimed invention determines the relevancy of an advertisement based on "a set of relevancy

2

rules associated with each ad" (where the relevancy rules may or may not depend on the content of the ad) compared to objects extracted from "the content of the information retrieved" ("free of information about the user") and "sends the targeted ad to the station for display with the content."

Emens neither discloses nor suggests displaying the requested content and the targeted ad together. Indeed, Emens discloses that either the requested information or the ad be shown. Emens further makes it clear that the ad should be shown only if the user specifically asks for it:

> The search engine then returns a specific search result set showing items which may contain the sought after information. For each search result item, a graphical user interface (GUI) selection is presented, allowing the user to select the GUI, on demand if so desired, to investigate related advertisement.

Emens, Col. 4, line 65 thru Col. 5, line 3

Claim 15 of the claimed invention is directed to a system for delivering ads which includes a matchmaker configured to "**directly send the targeted ad to the station for display with the content.**" Independent claim 89 recites similar subject matter. Independent method claim 21 recites the step of "displaying the targeted ads at the station with the content." In contrast, the Examiner acknowledges that Emens discloses that the "search result items and associated product icons are [] displayed to the browser 100." (Detailed Action, top of page 3.) The Examiner contends that "in Emens the icon or link that is displayed represent the ads." (Detailed Action, item 5, page 4.) Applicants respectfully disagree.

Emens, column 7, lines 50-51 disclose that "advertisements can [] be provided on the user's demand." Here Emens clearly distinguishes between an icon or link that is selected by a user, and an advertisement that is provided after the user makes a selection. Applicants submit that all

3

that Emens discloses displaying along with the search result is an icon or a link representing, or corresponding, to an ad, but not an advertisement itself..

Applicants assert that the icons are merely links to access the ads. They are not the ads themselves. Therefore, as noted above, Emens clearly teaches that the ads should not be shown with the content. Rather, it teaches that either the content or the ads should be shown, not both. Emens neither discloses nor suggests, displaying the ad with the content retrieved by the user. This feature is also missing from Herz. Thus, Emens and Herz does not render claims 15, 21 and 89 obvious for at least this reason.

In response to the arguments presented in Applicants' communication filed on September 25, 2006, the Examiner states that "the claims do not exclude accessing a link to receive the ad and secondly in Emens the icon or link that is displayed represent the ads. Each icon displayed corresponds to an ad." (Detailed Action, item 5, page 4.) The Examiner's comments, however, do not meet the language of the claim. Whether the claim fails to exclude accessing a link is not relevant. The claim requires that the matchmaker "**directly send the targeted ad to the station for display with the content**," not that a link is sent to the station by which the user can manually access the ad. Thus, Emens clearly fails to disclose an important feature of the invention. Additionally, Emens discloses that a graphical user interface or product icon is presented to the user. Selection of the GUI or icon initiates a search of an advertisement database to acquire information on advertised products related to the search results. (Emens, column 5, lines 44-59.) In contrast, the claimed invention "sends the targeted ad to the [user's] station for display with the content [retrieved by the user]."

Under the claimed invention content is pulled to a user's work station by the browser. The content being sought is not "a search query hav[ing] a special interest in [] a particular piece of information," as disclosed in Emens. A user of the claimed invention is seeking content in the form of news articles, or other web pages with full knowledge of their web location — i.e., their URL. The act of pulling certain content is implemented with the claimed invention by submission of the

4

known URL. The effect of submitting the URL in the present invention is that an advertisement and the content at the URL, are pulled to the work station for display together.

The Examiner contends that it would be obvious to use a URL to obtain the content in view of Herz. However, Emens clearly teaches away from Herz. Herz discloses a system where entering the URL for the system gets the expected content, i.e., the content that has been developed by the website, whether it be a collection of articles or ads. All the user ever gets is what the website had generated. Emens teaches that prior art systems (such as Herz) rely on user profiles to select advertising and that such systems are disadvantageous because, *inter alia*, they require continuous updating. *See* Emens, column 1. Emens teaches that this system should be rejected and, instead, Emens "follows an approach uniquely different from the e-commerce method of user profiling. Instead of using user profiles to target advertisement, the resultant search result items from a search engine performing an Internet search are utilized." (Emens, column 4, lines 54-58.) Having taught away from the process used in Herz, one skilled in the art would not look to Herz to modify the system disclosed in Emens. Thus, there is no motivation to combine Emens and Herz.

Combining Emens and Herz does not result in the claimed invention. If taken together, Emens and Herz must either (1) accept a user's query triggering a search engine to search the Internet, with the results being sent to a product matching manager to match the search result items to a product icon (as required by Emens' system); or (2) determine the relevancy of an advertisement based on its own content in comparison to a user's profile to develop a list of relevant ads to be sent to the user for possible reading (as required by Herz's disclosure).

The claimed invention does not have intervening entities as disclosed in Emens, neither does the claimed invention compare the advertisement's content to a user's profile as disclosed in Herz. Nor does the claimed invention require a user's query to trigger a search request in order to target an advertisement for display with content retrieved by the user. The claimed invention

5

determines the relevancy of an advertisement based on "a set of relevancy rules associated with each ad" (where the relevancy rules may or may not depend on the content of the ad) compared to objects extracted from "the content of the information retrieved" ("free of information about the user") and "sends the targeted ad to the station for display with the content."

Emens is directed to, and discloses, associating advertisements with individual search results obtained by a search engine. The search engine performs the search based on a query submitted by an Internet user. The search engine also performs a subsequent search for related product advertisements after uncovering the search result items. (Emens, Abstract.)

> When a user initially submits a query, a normal Internet search 90 is performed. The query is forwarded to the user/session manager subsystem 120 which then forwards it on to search engine 130. The search engine 130 performs an Internet search and produces a search results set. The search results set is then forwarded 97 to the product matching manager 140.

(Emens, column 6, lines 13-34; Fig. 3.) Emens discloses that the product matching manager 140 flags a search result item which matches an advertisement. The flag is used by a request server 160 (a/k/a results presentation manager) to display a GUI designator, e.g., a simple product icon. (Emens, column 6, lines 35-54.)

Thus, Emens interposes intervening entities (user/session manager 120 and search engine 130) in the path between the user's browser 100 and the Internet; and interposes other intervening entities (search engine 130, product matching manager 140, and request server 160) in the path between the Internet and the user's browser 100.

Emens does not disclose accessing content from a user-submitted URL, and acting on the accessed content as recited in the claimed invention. Rather, Emens discloses a system that accepts a **user's query 90, 95 for information,** conducts a search of the Internet through search engine 130, forwards 97 the search result set to a product matching manager 140, which attempts to match at least one product from its product database 110 to each of the search result items (as opposed to the content at a user-submitted URL.) If a user of Emens' system selects the icon, then

6

"the user/session manager 120 routes the product request 95 to the product presentation or product listing manager 150." This process continues with the product listing manager 150 referencing the product database 110, and then the result presentation manager 160 building a results page which contains the search result item with a list of products from which the user may select on demand. "This results page is sent 99 to the browser 100 to display the selected search result item with its corresponding products." (Emens, column 7, lines 29-42.) Thus, Emens does not disclose, nor suggest, causing the display of an advertisement as a result of the entry of a URL, let alone displaying the ad along with the content of the page referenced by the URL.

In order to compensate for the lack in Emens of any display of an ad in response to a URL, the Examiner cites Herz. Herz discloses a system that automatically constructs both a "target profile" for each target object (e.g., a news article, an advertisement, or a coupon) that the system receives. The Herz system also constructs and maintains a "target profile interest summary" for each user. When new material is received and processed, the system evaluates the target profiles against the user's target profile interest summaries to determine whether a listing of the article or ad is to be sent to the user. *See* Herz, Abstract. If so, Herz pushes a list of news articles or advertisements to the user, which are available for potential viewing by the user. The list is not sent together with any content the user has actively retrieved. In order to see the articles the user must go to the system website to download them.

The Examiner in the Office Action (page 3) states that:

> Herz teaches on Figure 10, 1102 a user accesses a news site and the articles delivered to the users are based on the user's submission. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have replaced Emens keyword search with the teachings of Herz of the content being accessed in response to the submission of a URL by the user because such a motivation would avoid unwanted articles in an irrelevant or unexpected context (Herz, col. 2, lines 43-53).

7

The Examiner has failed to appreciate that before an article is targeted by Herz's system, the user's profile is determined and the target profile is compared to the user profile. In particular, "a profile processing module which <u>estimates each user's interest in various target objects by reference to the users' target profile interest summaries</u>, for example by comparing the target profiles of these target objects against the search profiles in users' search profile sets, and generates for each user a customized rank-ordered listing of target objects most likely to be of interest to that user." *See* Herz, column 6, lines 42-58 (emphasis added). Further, merely putting in a URL and getting content is not the present invention. Rather, according to the present invention, when the URL is entered, the user gets the expected content, but also gets an ad related to that content. Using the Herz system, entering the URL for the system gets the expected content, i.e., the content that has been developed by the website, whether it be a collection of articles or ads. All the user ever gets is what the website had generated. With the present invention, putting in a URL not only gets the user the content at that website, but also an advertisement related to that content.

If the Emens' system were implemented at a search website, e.g., Google, entering the URL just gets you to the Google website. No ads are pulled to the user's browser as a result of entering the URL. If a search is entered and executed at Google, the search results would be returned to the user along with an icon. To actually get the ad, the user must click on the icon. Thus, it can be seen that entering a URL is already part of Emens in getting to the website where a search can be conducted. Combining Emens and Herz just gets you to a website, which may have especially prepared content (e.g., the user's favorite articles), but it does not produce an ad until a search is run. Even then the ad is not displayed for the user to see, but first it must be physically retrieved by clicking on a link or icon.

Independent claim 15 further recites that the matchmaker is "configured to, **in response to the submission of a URL by the user at the operating station, access the content retrieved by the user,** extract the content according to extracting rules, parse the content of the information into objects, target an ad from the server to the content by applying the relevancy rules in the data

8

store to the objects." (Emphasis added.) Independent claim 89 recites similar subject matter, and independent method claim 21 recites steps to accomplish these actions.

In contrast to triggering a search engine based on a user's query, the claimed invention causes a targeted advertisement to be displayed with content retrieved by the user after determining the relevancy of an advertisement based on "a set of relevancy rules associated with each ad" (where the relevancy rules may or may not depend on the content of the ad) compared to objects extracted from "the content of the information retrieved" ("free of information about the user"). After the relevance of an advertisement is determined, the claimed invention "sends the targeted ad to the station for display with the content." Applicants submit that Emens and Herz neither disclose nor suggest the claimed invention. Nor does the combination of Emens and Herz result in the claimed invention. Thus, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness over claims 15, 21 and 89.

In considering obviousness, the critical inquiry is whether something in the prior art as a whole suggests the desirability, and thus the obviousness, of making a combination. *In re Newell*, 891 F.2d 899, 901-02, 13 U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1992). The Examiner must show some objective teaching from the art that would lead an individual to combine the references, *i.e.*, there must be motivation. In particular, "[t]he mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added.) *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992). The Court of Appeals for the Federal Circuit has stated: "selective hindsight is no more applicable to the design of experiments than it is to the combination of prior art teachings. There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the Applicant's disclosure." *In re Dow Chemical Co.*, 5 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1988) (citations omitted).

In *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.* the Federal Circuit reinforced this "'as a whole' assessment" approach. *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*,

9

2005 U.S. App. LEXIS 10672 *1, *12; 75 U.S.P.Q.2D (BNA) 1051 (Fed. Cir. Jun. 9, 2005.) In *Princeton*, the court stated that to maintain an obviousness rejection it must be found that a person of ordinary skill in the art at the time of the invention, with no knowledge of the invention and solving the same problem, "would have selected the various elements from the [cited] prior art and combined them in the same manner." *Id.*

As noted above, Emens and Herz are not directed to solving the same problem (displaying a targeted advertisement with content retrieved by a user, where the relevancy of the advertisement is determined free of information about the user). Thus, there is no suggestion in Emens and Herz to combine these references. Additionally, there is no showing by the Examiner that a similarly situated person of ordinary skill solving the same problem would have selected the same elements from the cited art. Instead, the Examiner has impermissibly relied on the disclosure of the present application "to reconstruct the patentee's claimed invention from prior art by using the patentee's claim as a 'blueprint' when prior art references require selective combination to render obvious a subsequent invention." (*Dow Chemical Co.*, 5 U.S.P.Q. 2d at 1532, *citing Interconnect Planning Corporation v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985).)

Claims 32 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Emens in view of the Examiner's statement of what was known in the art at the time of the invention (Detailed Action, page 3, item 5.) Applicants respectfully traverse this rejection.

The Examiner contends that Emens and Herz discloses most of the features of claims 32 and 36. However, the Examiner acknowledges that Emens and Herz does not disclose that performance is measured by a change in revenues or click-through rates (claim 32), nor that content is classified by past consumption by users as a consequence of ads that were received and responded to by them (claim 36). The Examiner states that these approaches are "old and well known in the computer related arts," and that it would have been obvious for a person of ordinary skill in the art to have combined Emens, Herz, and the Examiner's statement of what is "old and well known" at the time of the invention to achieve the invention of claims 32 and 36.

10

First, the Examiner's statement that it is "old and well known . . . to monitor the amount of click through of an ad," and that it is "old and well known to classify information related to past consumption of prior products or coupons redemption by the consumer . . ." is not supported by any "concrete evidence in the record . . . ." (*See* MPEP § 2144.04(c), *citing In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).) Accordingly, Applicants submit that the Examiner is relying on personal knowledge and respectfully request that the Examiner supports this personal knowledge with affidavits containing data as specific as possible pursuant to 37 C.F.R. §1.104(d)(2). In accordance with § 1.104(d)(2), Applicants are permitted to contradict or explain such affidavits with affidavits of the Applicants or other persons. Applicants submit that without supporting evidence, the Examiner has impermissibly relied on personal knowledge and, thus, has not established a *prima facie* case of obviousness.

Second, claims 32 and 36 depend from independent claim 15, and recite the features of claim 15 as if set forth therein in their entirety. Applicants have demonstrated above that claim 15 is patentable over Emens and Herz. The above discussion is equally applicable to claims 32 and 36 in view of Emens, Herz, and the Examiner's statement. Applicant submits that the Examiner has not established a *prima facie* case of obviousness over claims 32 and 36. Further the present invention as set forth in claims 32 and 36 operates in a different way than the suggested combination. With the present invention, upon entering a URL the user gets the requested webpage and an ad. If the user clicks on the ad, performance metrics for the ad is generated.

In the combined Emens/Herz system, entry of a URL gets the user to a webpage where a search can be conducted. No ads are delivered. If a search is conducted, a list of search results is displayed. Again no ads are delivered. However, next to one or more of the search results there may be an icon. The user must than select which icon he/she wants and click on it. This produces an ad. Before a click-through (as commonly understood in the art) can be counted, the user must again click, this time on the ad itself. The present invention eliminates steps of creating a search, the user's choice of ads, and the extra click to generate the click-through which are necessary components in any system resulting from the combination of Emens and Herz. Thus, the claimed

11

invention is simpler for the user and guarantees that the user at least sees the ads that the advertiser wants shown.

Claims 16, 27-31, 32-35, 37-39 depend from claim 15. Claims 22, 40-88 depend from claim 21. Applicants submit that claims 16, 22, 27-31, 32-35 and 37-88 are patentable over Emens, Herz and the Examiner's statement of what was known in the art, for at least the same reasons as their respective base claims.

Reconsideration and withdrawal of the rejection is requested.

CONCLUSION

Each and every point raised in the Office Action dated December 11, 2006 has been addressed on the basis of the above amendments and remarks. In view of the foregoing it is believed that Claims 15, 16, 21, 22 and 27-89 are in condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Dated: April 11, 2007

Respectfully submitted,

By_____
Richard J. Katz
Registration No.: 47,698
DARBY & DARBY P.C.
P.O. Box 5257
New York, New York 10150-5257
(212) 527-7700
(212) 753-6237 (Fax)
Attorneys/Agents For Applicants

12